

ESTTA Tracking number: **ESTTA768506**

Filing date: **09/02/2016**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	92062051
Party	Defendant NOMOO, LLC
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Date	09/02/2016
Attachments	1-main.pdf(112857 bytes) 1-1.pdf(58148 bytes) 1-2.pdf(47424 bytes)

UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF MASSACHUSETTS

JUDITH U. HERRELL, HERRELL'S
DEVELOPMENT CORPORATION,
HERRELL'S
Plaintiff

V.

NOMOO LLC.
Defendant

CIVIL ACTION NO.

COMPLAINT
(And jury demand)

NATURE AND BASIS OF ACTION

1. This is an action by Judith U. Herrell (“Ms. Herrell”), Herrell’s Development Corporation (“Herrell’s Development”) and Herrell’s Ice Cream Corporation (“Herrell’s Ice Cream”) (collectively “Plaintiffs”) against NoMoo LLC (“LLC”) for trademark infringement, cancellation of trademark, and trademark dilution. Development and Ice Cream, as trademark licensees, seek injunctive relief and damages for trademark infringement under Sections 14 and 32 of the Trademark Act of 1946, as amended, 15 U.S.C. §§ 1114, 1116, and 1125(a) (“the Lanham Act”), and for infringement of a famous mark under Section 43(c) of the Lanham Act, 15 U.S.C. §1125(c). Ms. Herrell seeks cancellation of a trademark under Sections 32 and 37, 15 U.S.C. §§ 1114, 1119.

PARTIES

1. Plaintiff Judith U. Herrell is an individual with a business address at 8 Old South Street, Northampton, Massachusetts 01067.

2. Ms. Herrell is the owner by assignment of a registration on the Principal Register of the United States Patent & Trademark Office for the trademark *No-Moo* (No. 1540730)(“No-Moo Mark”).

3. Plaintiff Herrell’s Development is a corporation duly organized under the laws of the Commonwealth of Massachusetts.

2. Plaintiff Herrell’s Ice Cream is a corporation duly organized under the laws of the Commonwealth of Massachusetts.

3. Defendant NoMoo, LLC (“LLC”) is a limited liability company organized under the laws of the State of Delaware with a business address of 5118 Applebutter Road, Pipersville, Pennsylvania 18947 doing business as NoMoo Cookie Company.

4. LLC is the owner of a registration on the Principal Register of the United States Patent & Trademark Office for the trademark NoMoo (Registration No. 4,692,455). (“NoMoo Mark”).

JURISDICTION AND VENUE

5. This Court has original subject matter jurisdiction of this matter pursuant to 15 U.S.C. § 1119 and 28 U.S.C. §1331, as this case arises under the Lanham Act, 15 U.S.C. §§ 1064, 1114, 1121, and 1125(a) and (c), Venue is proper in this Court under 28 U.S.C. §1391(c), as NoMoo is a limited liability corporation subject to personal jurisdiction in this judicial district. Venue in the Western Division of this Court is proper pursuant to Local Rule 40.1(D)(1)(c).

FACTUAL ALLEGATIONS

Herrell's Corporate and Trademark History

1. In 1980, Ms. Herrell's predecessor-in-interest, Stephen Herrell ("Mr. Herrell"), d/b/a Herrell's Ice Cream opened an ice cream parlor in Northampton, Massachusetts. ("Northampton store").
2. On May 23, 1989, the United States Patent and Trademark Office ("USPTO") issued to Mr. Herrell a registration for the word mark "No-Moo" in connection with non-dairy frozen confections for consumption on and off the premises in International Trademark Class 30, with a stated date of first use of April 29, 1985, and a stated date of first use in commerce of November 28, 1986.
3. From November 1986 until August 19, 2011, Mr. Herrell engaged in substantially exclusive and continuous use of the No-Moo Mark in interstate commerce in connection with non-dairy frozen confections for consumption on an off the premises, in part through two corporations, Herrell's Ice Cream (of which he was sole stockholder, and which owns and operates the Northampton store), and Herrell's Ice Cream, Inc. (a wholly-owned subsidiary of Herrell's Ice Cream Corp., which was later consolidated with Herrell's Ice Cream Corp.), and in part through franchisees and licensees under franchise and license agreements with Herrell's Ice Cream Corp, and later with Herrell's Development Corp.
4. On August 19, 2011, Mr. Herrell assigned a one-half interest in the No-Moo Mark to Ms. Herrell.
5. Simultaneous with the assignment, Mr. Herrell and Ms. Herrell entered into written license agreements with Herrell's Ice Cream and Herrell's Development

6. On or about February 6, 2014, Mr. Herrell conveyed to Ms. Herrell all of his ownership interests in Herrell's Ice Cream and Herrell's Development.

7. Simultaneous with such transaction, Mr. Herrell assigned to Ms. Herrell his one-half interest in the No-Moo Mark, so that, after the assignment, Ms. Herrell became the sole owner of the No-Moo Mark.

8. As sole owner of the No-Moo Mark, Ms. Herrell then entered into license agreements with both Herrell's Ice Cream and Herrell's Development.

9. Herrell's Ice Cream has engaged in substantially exclusive and continuous use of the No-Moo Mark in interstate commerce in connection with non-dairy frozen confections since 1986.

10. In or about 1993, Herrell's Ice Cream began selling non-dairy baked goods under the No-Moo Mark for consumption on and off the premises at its Northampton, Massachusetts.

11. The No-Moo Mark had been in continuous and substantially exclusive use in connection with non-dairy baked goods by Ms. Herrell, through her authorized licensees, Herrell's Ice Cream and Herrell's Development, and their licensees and franchisees, since 1993.

12. On July 31, 2015, Ms. Herrell applied to the USPTO for registration of the No-Moo Mark on the Principal Register for non-dairy baked goods for consumption on or off the premises. (Serial No. 86710786)

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